

Appl. No. 10/505,286  
Amendment and/or Response  
Reply to Office action of 12 December 2006

Page 6 of 11

RECEIVED  
CENTRAL FAX CENTER

APR 12 2007

**REMARKS/DISCUSSION OF ISSUES**

By this Amendment, Applicants amend claims 1, 2 and 6, cancel claim 3, and add new claims 7-21. Accordingly, claims 1-2 and 4-21 are pending in the application.

Applicants thank the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority documents.

The Examiner is respectfully requested to state whether the drawings are acceptable.

Claims 1, 2 and 6 are amended for non-statutory reasons, to correct typographical errors, and for minor clarification. The claims are not narrowed in scope and no new matter is added.

Reexamination and reconsideration are respectfully requested in view of the following Remarks.

**35 U.S.C. § 102 and 103**

The Office Action rejects claims 1-2, 4 and 6 under 35 U.S.C. § 102 over Brady et al. U.S. Patent Publication 2002/0003496 ("Brady"), and claim 5 under 35 U.S.C. § 103 over Brady.

Applicants respectfully traverse those rejections for at least the following reasons.

**Claim 1**

Among other things, in the method of claim 1 the transponder IC is brought into communication-capable connection, via each one of its two IC contacts with a corresponding one of two transmission element strips provided on a tape-like carrier of an intermediate product and extending substantially parallel to the longitudinal direction of the carrier.

Applicants respectfully submit that Brady does not show any method including such features. In particular, Brady discloses a carrier including a plurality of separate individual antenna circuits 318, such as coils, dipoles, loops, spirals, meanders, patches, etc. However, Brady does not disclose or suggest any "transmission

Atty. Docket No. AT-020010

Appl. No. 10/505,286  
Amendment and/or Response  
Reply to Office action of 12 December 2006

Page 7 of 11

element strips provided on a tape-like carrier extending substantially parallel to the longitudinal direction of the carrier." Antenna circuits 318 are not strips extending substantially parallel to the longitudinal direction of the carrier.

Accordingly, for at least these reasons, Applicants respectfully submit that claim 1 is patentable over Brady.

Claims 2, and 4-6

Claims 2 and 4-6 all depend from claim 1 and are patentable for at least the reasons set forth above with respect to claim 1, and for the following additional reasons.

Claim 4

Among other things, in the method of claim 4 the transponder IC is connected to the portion of the intermediate product by a glued joint.

Applicants respectfully submit that Brady does not show any method including such features.

The Office Action states without any support or citation that "[t]he transponder is glued because it is held fast as if by gluing."

At the outset, claim 4 does not state that the transponder is "held fast as if by gluing." It says that the transponder IC is connected to the intermediate product by a glue joint. The Examiner is respectfully requested to avoid paraphrasing Applicant's claims, and to examine the actual language recited in the claims. If the Examiner is unable to cite anything in Brady disclosing that a transponder IC is connected to the intermediate produce by a glue joint, then he is respectfully requested to withdraw the rejection of claim 4 over Brady under 35 U.S.C. § 102.

Second, the Office Action provides no citation in support of the statement that "[t]he transponder is glued because it is held fast as if by gluing." A rejection under 35 U.S.C. § 102 cannot be supported on unknown authority, but must be supported by objective evidence of record. See M.P.E.P. § 2144.03A. A citation in support of this statement should be provided, or the statement should be withdrawn.

Accordingly, for at least these additional reasons, Applicants respectfully submit that claim 4 is patentable over Brady.

Atty. Docket No. AT-020010

Appl. No. 10/505,286  
Amendment and/or Response  
Reply to Office action of 12 December 2006

Page 8 of 11

### Claim 5

Among other things, in the method of claim 5, a transponder IC with a quadrilateral main surface is used, in which transponder IC the IC contacts are provided in two corner areas of the main surface lying on a diagonal of the main surface and wherein the transponder IC is connected to the portion of the intermediate product in such a position that the diagonal of the main surface extends perpendicularly to the longitudinal direction of the carrier.

The Office Action cites nothing whatsoever in the prior art disclosing or suggesting any of these features.

Instead the Office Action makes an unsupported statement that it would have been obvious to modify Brady to include such features, allegedly because such positioning does not provide any unexpected advantages or solve any problems in the disclosed process.

Applicants respectfully disagree.

At the outset, the recited features absolutely do provide specific advantages and benefits and solve problems with Brady's arrangement. Some of these advantages are clearly mentioned in the specification, for example at page 7, lines 14-21. Other benefits of the claimed method over Brady's arrangement are disclosed, for example, at page 3, lines 3-11.

So Applicant's traverse the unsupported statement that the arrangement does not provide unexpected benefits and advantages, and solve problems that may present themselves with Brady's arrangement.

Meanwhile, M.P.E.P. § 2143.03 provides that ALL features must be taught or suggested to support a rejection under 35 U.S.C. § 103. And M.P.E.P. § 2144.03A provides that a rejection under 35 U.S.C. § 103 cannot be supported on unknown authority, but must be supported by objective evidence of record.

Here the Office Action fails to cite anything in the prior art that discloses or suggest the features of claim 6, or provide any objective evidence of record to support a rejection under 35 U.S.C. § 103. If the Examiner takes "official notice" that the proposed modification of Brady would have been obvious to one of ordinary skill

Atty. Docket No. AT-020010

Appl. No. 10/505,286  
Amendment and/or Response  
Reply to Office action of 12 December 2006

Page 9 of 11

in the art at the time of the invention, that position must be based on facts capable of instant and unquestionable demonstration as being "well-known" in the art, and the Examiner must be prepared to cite a reference in support of that position, or file an affidavit under 37 CFR 1.104(d)(2) if the rejection is based on facts within his or her personal knowledge. MPEP § 2144.03.

Accordingly, for at least these additional reasons, Applicants respectfully submit that claim 5 is patentable over Brady.

### **NEW CLAIMS 7-21**

#### **Claims 7-12**

New claims 7-12 all depend from claim 1 and are deemed patentable over Brady for at least the reasons set forth above with respect to claim 1, and for the following additional reasons.

Brady does not disclose or suggest any of the following features variously recited in claims 7-12: each IC contact is in capacitive communication with the relevant transmission element strip (claim 7); the two transmission element strips include the two substantially planar transmission elements of the transponder and two substantially planar transmission elements for another transponder (claim 8); when the intermediate product is cut, the cutting separates the two substantially planar transmission elements of the transponder from the two substantially planar transmission elements for the other transponder (claim 9); when the intermediate product is cut, the cutting cuts through both of the two transmission element strips to separate the two substantially planar transmission elements from the two transmission element strips (claim 10); the two transmission element strips are each longer in the longitudinal direction than in a transverse direction perpendicular to the longitudinal direction (claim 11); and the two IC contacts are provided as strips extending opposite along opposite edges of the transponder IC (claim 12).

Accordingly, for at least these reasons, Applicants respectfully submit that claims 7-12 are all patentable over Brady.

Atty. Docket No. AT-020010

Appl. No. 10/505,286  
Amendment and/or Response  
Reply to Office action of 12 December 2006

Page 10 of 11

RECEIVED  
CENTRAL FAX CENTER  
APR 12 2007

### Claims 13-21

Among other things, all of the methods of claims 13-21 include providing a tape-like carrier of an intermediate product having two transmission element strips provided thereon, the transmission element strips extending parallel to each other along a longitudinal direction of the carrier which is longer than a transverse direction of the carrier, and cutting through the carrier and the two transmission element strips along two cutting zones extending perpendicularly to the longitudinal direction of the carrier and each lying at a distance from the transponder.

Applicants respectfully submit that Brady does not disclose such a combination of feature, particularly cutting through the carrier and the two transmission element strips along two cutting zones extending perpendicularly to the longitudinal direction of the carrier and each lying at a distance from the transponder.

Accordingly, for at least these reasons, Applicants respectfully submit that all of the claims 13-21 are patentable over Brady.

Furthermore, Brady does not disclose or suggest any of the following features variously recited in claims 14-21: gluing the transponder IC to the tape-like carrier (claims 15-16, 18 and 21); each IC contact is in capacitive communication with the relevant transmission element strip (claims 17 and 18); and the transponder IC has a quadrilateral main surface, in which transponder IC the IC contacts are provided in two corner areas of the main surface lying on a diagonal of the main surface and wherein the transponder IC is connected to the portion of the intermediate product in such a position that the diagonal of the main surface extends perpendicularly to the longitudinal direction of the carrier (claims 19-21).

Accordingly, for at least these reasons, Applicants respectfully submit that claims 13-21 are all patentable over Brady.

### CONCLUSION

In view of the foregoing explanations, Applicants respectfully request that the Examiner reconsider and reexamine the present application, allow claims 1, 2 and 4-21 and pass the application to issue. In the event that there are any outstanding

Atty. Docket No. AT-020010

Appl. No. 10/505,286  
Amendment and/or Response  
Reply to Office action of 12 December 2006

Page 11 of 11

matters remaining in the present application, the Examiner is invited to contact Kenneth D. Springer (Reg. No. 39,843) at (571) 283.0720 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this reply to charge payment or credit any overpayment (except for the issue fee) to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17, particularly extension of time fees.

Respectfully submitted,

VOLENTINE &amp; WHITT

Date: 12 April 2007By: 

Kenneth D. Springer  
Registration No. 39,843

VOLENTINE & WHITT  
One Freedom Square  
11951 Freedom Drive, Suite 1260  
Reston, Virginia 20190  
Telephone No.: (571) 283.0724  
Facsimile No.: (571) 283.0740

Atty. Docket No. AT-020010